

REMARKS

Claims 1-44 are currently pending in the present application. Claim 2 was previously cancelled, and claims 5-9 and 14-44 previously withdrawn due to a restriction requirement. By virtue of this response, claims 1, 3-4, and 11-13 have been amended. Support for the amendment is found throughout the specification as originally filed. No new matter has been added. Accordingly, claims 1, 3-4, and 10-13 remain under consideration. Amendment and cancellation of certain claims is not to be construed as a dedication to the public of any of the subject matter of the claims as previously presented.

Claim Rejections – 35 U.S.C. § 103(a)

Claims 1, 3-4, and 10-13 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. 5,910,512 to Conant (Conant) in view of Wholehealthmd (cited in the Office Action dated June 15, 2003). The present Office Action states that Conant fails to teach the claimed kit having separate components, but that in view of Wholehealthmd, it would have been obvious to one of ordinary skill in the art at the time of the instant invention to include a second component that cleanses or dilutes the residual capsaicin after application. This is because Wholehealthmd teaches that capsaicin causes burning and stinging, and suggests diluting the capsaicin composition in order to prevent the burning and stinging sensation.

Applicants respectfully submit that Conant is improperly cited as a primary reference in attempting to establish obviousness. Conant is concerned with the problem of burning or stinging from the strong solvents used in topical analgesics and also with the drying out of skin due to the use of these harsh solvents (column 1, lines 35-61). As a solution, Conant describes using hydrocolloid extracts as a base because they are not harsh on the skin and soften the epidermis to enhance delivery of analgesic into the skin (column 1, line 57 to column 2, line 5). Given that capsaicin is normally not water soluble, harsh solvents such as alcohol or chloroform must typically be used (column 1, lines 34-36). In order to avoid using harsh solvents when formulating topical analgesics containing capsaicin, Conant teaches the use of a water soluble capsaicin, specifically oleoresin capsicum, that can be used with a hydrocolloid (hydrophilic) base (see column 1, line 13;

column 1, lines 54-56; column 2, lines 13-14; column 2, lines 23-27; and page 3, first full paragraph of Office Action dated June 6, 2007).

Pending claims 1, 3-4, and 10-13 recite a kit that includes capsaicin, which is practically water insoluble (Merck Index, 14th Edition, p.1765), and also disclosed by Conant as being practically insoluble in water (column 2, line 46). As mentioned above, Conant includes water soluble capsaicin in his formulation so that it can be used with a hydrophilic base that results in less stinging and burning of the skin. Thus, because practical water insolubility is an inherent property of capsaicin, Applicants contend that Conant teaches away from the claimed kit. Given that Conant teaches away from the use of water insoluble capsaicin, the combination of Conant and the Wholehealthmd reference need not be discussed.

Accordingly, withdrawal of the rejection of claims 1, 3-4, and 10-13 under 35 U.S.C. § 103 (a) is respectfully requested.


CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. 524522000500. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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Respectfully submitted,

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